

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES
Attorney Docket No.: 15037US02**

In the Application of:)	
)	
Jeyhan Karaoguz, et al.)	<u>Electronically Filed On November 24, 2009</u>
)	
Serial No.: 10/675,436)	
)	
Filed: September 30, 2003)	
)	
For: MEDIA PROCESSING SYSTEM)	
COMMUNICATING ACTIVITY)	
INFORMATION TO SUPPORT USER)	
AND USER BASE PROFILING AND)	
CONSUMPTION FEEDBACK)	
)	
Examiner: Duffield, Jeremy S.)	
)	
Group Art Unit: 2427)	
)	
Confirmation No.: 5627)	

REPLY BRIEF

Mail Stop Appeal Brief – Patents
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

This Paper responds to the Examiner's Answer mailed September 29, 2009. The Applicants respectfully request that the Board of Patent Appeals and Interferences reverse the final rejection of claims 1-37 of the present application for at least the reasons set forth in the Second Appeal Brief filed July 8, 2009 and this Reply Brief.

REMARKS

As explained previously, the Applicants filed a First Notice of Appeal and First Appeal Brief.¹ In response to that Appeal Brief, the Examiner indicated that “Applicant’s arguments with respect to claims 1-37 have been considered but are moot in view of the new ground(s) of rejection.”² The Examiner then noted the following:

To avoid abandonment of the application, appellant must exercise one of the following two options:

- (1) file a reply under 37 CFR 1.111 ...; or,
- (2) initiate a new appeal by filing a notice of appeal under 37 CFR 41.31 followed by an appeal brief under 37 CFR 41.37. The previously paid notice of appeal fee and appeal brief can be applied to the new appeal.³

Therefore, the Applicants filed a Second Notice of Appeal and a Second Appeal Brief.

The Applicants note that the arguments set forth in the Examiner’s Answer are essentially identical to those set forth in the June 15, 2009 Office Action. *Compare* Examiner’s Answer at pages 3-12 *with* June 15, 2009 Office Action at pages 2-12. Accordingly, the Second Appeal Brief addresses these arguments and explains that they do not establish a *prima facie* case of unpatentability at pages 7-20. To the extent that the Examiner’s Answer raises new arguments at pages 13-17 in the “Response to Argument” section, the Applicants will address these below.

¹ See March 11, 2009 Notice of Appeal and Appeal Brief.

² See June 15, 2009 Office Action at page 2.

³ See *id.*

I. The Proposed Combination Of Goldman And Hendricks Does Not Render Claims 1-8 Unpatentable

A. Contrary To The Assertion In the Examiner's Answer, Goldman Does Not Describe, Teach Or Suggest Determining, At The First Location, Whether The Associated Set Of Pre-Defined Characteristics Matches At Least One Parameter ...

As explained previously, Goldman discloses a system in which viewer television habits are monitored, and those habits are compiled to update electronic program guides. *See* Second Appeal Brief at, for example, pages 9-10. Instead of quoting portions of Goldman that allegedly disclose the relevant claim limitations, the Examiner's Answer merely lists a few paragraph numbers from Goldman. *See* Examiner's Answer at pages 13-14. This is in stark contrast to the Second Appeal Brief, which clearly cites to specific portions of Goldman, and, indeed, reproduces portions of Goldman that the Office Action relies upon and demonstrates their deficiencies. *See* Second Appeal Brief at pages 10-17.

The Examiner's Answer fails to quote anything from Goldman that describes, teaches or suggest the relevant "matching." *See* Examiner's Answer at pages 13-14. The Examiner's Answer resorts to stating "as clearly seen above" [from merely listing paragraph numbers] that Goldman discloses the relevant claim limitation. Notably, however, the explanation of what is allegedly "clear" from Goldman does not include any actual quotations from Goldman. *See id.* Instead, it merely makes a series of unsupported conclusory statements in order to maintain the rejection. However, "[t]he Supreme Court in *KSR International Co. v. Teleflex Inc.*, 82 USPQ2d 1385, 1396 (2007) noted that the analysis supporting a rejection under 35 U.S.C. 103 **should be made explicit**. The Federal Circuit has stated that "rejections on obviousness cannot be sustained with **mere conclusory statements....**" *See* the MPEP at § 2142, citing *In re Kahn*,

441 F.3d 977, 988, 78 USPQ2d 1329, 1336 (Fed. Cir. 2006), and *KSR International Co. v. Teleflex Inc.*, 82 USPQ2d at 1396 (quoting Federal Circuit statement with approval).

It bears repeating, however, that, in direct contrast to the conclusory statements in the Examiner's Answer (e.g., "Para. 31-36" in connection with "as clearly shown above"), the Applicants actually expose the portions of Goldman that the Office Action relies on and demonstrate their deficiencies. *See* Second Appeal Brief at pages 11-17. Moreover, as the Applicants demonstrate, Goldman does not describes, teach or suggest that its **home entertainment system 90**, which the Examiner's Answer relies upon as the "first location" (*see* Examiner's Answer at page 4), makes any kind of determination as to whether a set of characteristics of "viewer behavior information" [which the Examiner's Answer concludes is a "media request" (*see id.*)] **matches** anything, let alone a parameter related to monitoring activity of a user at that **home entertainment system 90**. *See* Second Appeal Brief at pages 11-13, for example.

Again, claim 1, for example, recites, in part, "determining, at the first location, whether the associated set of pre-defined characteristics [associated with the **requested media**] **matches** the at least one parameter [related to monitoring media consumption activity of the user at the first location]; **sending notification of the media request** to a second location, via a communication network, if the determining results in a match; and **refraining from sending a notification of the media request** to the second location, via the communication network, if the determining does not result in a match." The Examiner's Answer has not shown where any of the cited references describes, teaches or suggests these limitations. *See* Second Appeal Brief at

pages 10-17. Thus, for at least the reasons set forth in the Second Appeal Brief and above, the Applicants respectfully request reconsideration of the claim rejections.

Additionally, in response to the Applicants' argument that the cited references do not describe, teach or suggest "sending notification of a media **request** (not consumption, *per se*, of the media) to a **second location** if the determination **results in a match**" (*see* Second Appeal Brief at pages 10-17), the Examiner's Answer simply states that the "examiner respectfully disagrees" while adding more unsupported statements. *See* Examiner's Answer at page 14. Again, the Examiner's Answer makes no attempt to actually quote portions of the cited references to support its statements. *See id.*

For at least the reasons set forth in the Second Appeal Brief and above, the Applicants respectfully request reconsideration of the claim rejections.

B. The Office Action Has Not Shown That Any Of The Cited References Describe, Teach Or Suggest "Refraining," As Recited In Claim 1

The Office Action acknowledges that "Goldman does not explicitly teach refraining from sending a notification of the media request to the second location, via the communication network, if the determining does not result in a match." *See* June 15, 2009 Office Action at page 4. Indeed, the Examiner's Answer reiterates this exact same statement. *See* Examiner's Answer at page 5.

Yet, the Office Action later **contradicts itself** and the previous Office Action by stating that "Goldman teaches matching data requested from the clearinghouse with data associated with a media request and sending the matched data to the clearinghouse **while refraining from sending data that does not match.**" *See* Examiner's Answer at page 15.

The Applicants respectfully submit that this inconsistency reflects what seems to be a determined effort to refuse allowance at all costs. Indeed, the Examiner's Answer now attempts to incorporate portions of the specification into the claims. *See* Examiner's Answer at page 15. However, such a practice runs afoul of patent examining procedure. *See*, for example, MPEP at § 2111.01(I) ("One must bear in mind that, especially in nonchemical cases, the words in a claim are generally not limited in their meaning by what is shown or disclosed in the specification"). "Though understanding the claim language may be aided by explanations contained in the written description, **it is important not to import into a claim limitations that are not part of the claim.**" *See Superguide Corp. v. DirecTV Enterprises, Inc.*, 358 F.3d 870, 875, 69 USPQ2d 1865, 1868 (Fed. Cir. 2004).

Additionally, the Applicants demonstrate that Hendricks does not describe, teach or suggest the relevant "refraining." *See* Second Appeal Brief at pages 17-19. The portion of Hendricks that the Examiner's Answer relies upon (namely Hendricks at column 28, lines 3-15) makes no mention of a determination of whether a "match" exists with respect to a media request. Also, in stark contrast to "**refraining** from sending a notification," the cited portion of Hendricks clearly indicates that the terminal actually **responds**, as opposed to refraining from responding or sending a notification. *See* Second Appeal Brief at pages 17-19.

In short, if Hendricks (like Goldman) did disclose the relevant claim limitations, the Examiner's Answer would not need a full page and more of unsupported argument to explain how and where they did disclose the relevant claim limitations, such as shown, for example, at page 16 of the Examiner's Answer. Instead, the Examiner's Answer would be able to clearly cite a portion of the cited references, and reproduce the actual portion (as opposed to resorting to

lengthy arguments without actual language from the references) in response to the Applicants' explanations. As evident, however, the Examiner's Answer is unable to set forth such a straightforward rejection.

Thus, for at least these reasons, and those set forth in the Second Appeal Brief, the Applicants respectfully request reconsideration of the claim rejections.

III. Conclusion

For at least the reasons discussed in the Second Appeal Brief and above, the Applicants respectfully submit that the pending claims are allowable in all respects with respect to the cited art. Therefore, the Board is respectfully requested to reverse the rejections of pending claims 1-37.

PAYMENT OF FEES

The Commissioner is authorized to charge any necessary fees, or credit overpayment to Deposit Account 13-0017.

Respectfully submitted,

Dated: November 24, 2009

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